

### **REMARKS/ARGUMENTS**

The Final Office Action of September 16, 2003, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1, 10, and 16 have been amended. Claim 7 has been canceled. Claims 1-6 and 8-29 remain pending.

Applicants wish to thank the Examiner for the courtesies extended in allowing Applicants the opportunity to conduct the Examiner Interview on December 10, 2003. It is believed that the present amendment to claims 1, 10, and 16 further clarifies the present invention. However, in the event any outstanding issues remain, the Examiner is invited to contact the undersigned at the number listed below.

#### **Rejections under 35 U.S.C. § 103(a)**

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cassorla et al. (U.S. Patent No. 5,146,552, hereinafter referred to as *Cassorla*) in view of Admitted Prior Art (APA). Applicants respectfully traverse this rejection.

In regards to Applicants' claim 1, the combination of *Cassorla* and APA fails to teach or describe, among other features, Applicants' feature, "wherein step (3) comprises the step of storing a separate stroke for each annotation, wherein each stroke corresponds to a continuous set of movement when the user input device is activated." Applicants' claim 1 has been amended to incorporate those features of original dependent claim 7.

The Action cites Figure 1 of *Cassorla* as describing this feature of Applicants' claim 7. Figure 1 of *Cassorla* shows a display 26 with an image of a formatted text stream 25' and images of annotation strings 24'. Images of annotation strings 24' are merely text-based keyboard 50 entered annotations that are associated with particular paragraphs, subparagraphs, etc. of the image of the formatted text stream 25'. *Cassorla* is an entirely text-based system. With *Cassorla*, a user cannot enter a freehand stroke. All entries are text-based entries with predefined characteristics. A user can choose a color or type style, but she cannot underline content so that the line is not straight, or passes through content on the display. As shown in

Figures 2 and 3 of *Cassorla*, text is formatted into a text stream and annotations are displayed adjacent to a paragraph of the formatted text. Under Applicants' system, as clearly shown in Figures 6 and 7, a user can input strokes that are not text-based, but graphics-based, i.e., based on pixel-blending.

The combination of *Cassorla* and APA fails to teach, suggest, or describe a "stroke" for storage of an annotation. At best, *Cassorla* allows a user to associate a text-based annotation "adjacent to", "next to", or "proximate to" a formatted paragraph; however, *Cassorla* fails to teach or suggest, "wherein step (3) comprises the step of storing a separate stroke for each annotation, wherein each stroke corresponds to a continuous set of movement when the user input device is activated," as recited, among other features, in Applicants' claim 1.

The Action relies on the same basis for rejection of Applicants' claim 1 to reject Applicants' claim 10. Applicants' claim 10 has been amended to incorporate those features of original dependent claim 7. Applicants' claim 10 is patentably distinct over the combination of *Cassorla* and APA for substantially the same reasons as recited above in reference to Applicants' independent claim 1.

Applicants' claims 2-6, 8-9, and 21-23, which depend from claim 1, and claims 11-15 and 24-26, which depend from claim 10, are patentably distinct over the combination of *Cassorla* and APA for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

For example, *Cassorla* fails to teach or suggest, "using opaque markings that obscure portions of the currently displayed document page," as recited, among other features, in Applicants' claim 2, and, "wherein the computer software displays and stores opaque annotations that obscure annotated portions of the currently displayed document page," as recited, among other features, in Applicants' claim 11. The Action cites Figure 1 of *Cassorla* as teaching these features. Figure 1 of *Cassorla* shows a display 26 with an image of a formatted text stream 25' and images of annotation strings 24'. Images of annotation strings 24' are merely text-based keyboard 50 entered annotations that are associated with particular paragraphs, subparagraphs, etc. of the image of the formatted text stream 25'. Even assuming a proper motivation to combine, neither this portion, nor any other portion of *Cassorla*, either alone or in combination

with APA, teach or suggest, “using opaque markings that obscure portions of the currently displayed document page,” as recited, among other features, in Applicants’ claim 2, and, “wherein the computer software displays and stores opaque annotations that obscure annotated portions of the currently displayed document page,” as recited, among other features, in Applicants’ claim 11.

In addition, *Cassorla* fails to teach or suggest, “blending pixels from the currently displayed document with a translucent color to produce a translucent annotation,” as recited, among other features, in Applicants’ claim 4, and, “wherein the translucent annotation is generated by blending pixels from the currently displayed document with a highlighting pixel color,” as recited, among other features, in Applicants’ claim 18. The Action cites column 4, lines 4-43 of *Cassorla* as teaching these features. The cited portion describes placemarks, bookmarks, highlighting and margin flags. Indeed, the cited portion describes highlighting context and identifying a color or type style, but fails to describe anything as to pixel blending. Neither this portion, nor any other portion of *Cassorla*, either alone or in combination with Applicants’ written description teach or suggest, “blending pixels from the currently displayed document with a translucent color to produce a translucent annotation,” as recited, among other features, in Applicants’ claim 4, and “wherein the translucent annotation is generated by blending pixels from the currently displayed document with a highlighting pixel color,” as recited, among other features, in Applicants’ claim 18.

*Cassorla* is deficient also in regards to Applicants’ claims 5 and 13. Applicants’ claim 5 recites, among other features, “using an erase highlighting that erases previously annotated areas of the currently displayed document page.” Applicants’ claim 13 recites, among other features, “wherein the computer software displays and stores erased annotations that remove previously made annotations on the currently displayed document page.” The Action cites Figure 1 of *Cassorla* as disclosing, “instructions for erasing portions of previously created annotations” to reject Applicants’ claim 5. The Action cites Figure 3 of *Cassorla* as disclosing, “computer software [that] displays and stores erased annotations that remove previously made annotations on the currently displayed document page” to reject Applicants’ claim 13. At best, *Cassorla* allows for the revision or deletion of previously created annotations 28. (Col. 9, lines 57-58).

However, because the system in *Cassorla* is text-based, a user cannot use an erase highlighting to erase portions of a graphical entry such as the entry shown in Applicants' Figure 7. Clearly, the text-based system of *Cassorla* fails to teach or suggest these features of Applicants' claims 5 and 13.

With respect to Applicants' amended independent claim 16, the combination of *Cassorla* and APA at least fails to teach or suggest Applicants' claim 16 feature, "displaying the annotations in an ink layer that is superimposed over and blended with pixels on the electronic document page." As stated above with reference to Applicants' independent claim 1, at best, *Cassorla* is an entirely text-based system that allows a user to associate a text-based annotation "adjacent to", "next to", or "proximate to" a formatted paragraph. The combination of *Cassorla* and APA fails to teach or suggest, "displaying the annotations in an ink layer that is superimposed over and blended with pixels on the electronic document page."

Applicants' claims 17-20 and 27-28, which depend from claim 16, are patentably distinct over the combination of *Cassorla* and APA for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.


Applicants' claim 29 recites, among other features, "displaying the annotation in an ink layer that is superimposed over and blended with pixels on the document page." Applicants' claim 29 is patentably distinct over the combination of *Cassorla* and APA for substantially the same reasons as recited above in reference to Applicants' independent claim 16. As such, Applicants' respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a).

**CONCLUSION**

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. No fee is believed due, however, if any fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733. Applicants look forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,  
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